

almost all of the fluid from the container, regardless of whether the filter is mounted to a straw used in the normal upright attitude, or mounted to the bottle top, with the shroud inverted.

Reconsideration is respectfully requested of the rejection of claims 1, 5, 12 and 13 as originally presented, or as now amended, as anticipated by the 1902 Hall patent. Hall is a canteen requiring significant pressurization, much more than the nominal 1 to 2 psi maximum which is applied by either mouth suction (for a straw mounted filter assembly according to the invention) or by inverting and squeezing the bottle (for the cap mounted filter element according to the invention). To be functional the Hall design requires a chamber for the water to accumulate since a flow through micro-porous structure is provided that is so slow that it would be useful for functionality associated according to the present invention. Hall requires an air vent, and the Hall structure would function only in the upright vertical plane and thus has absolutely no use whatsoever for the inverted design of utilization (the figure 1 embodiment) according to the present invention.

In Hall an unglazed porous porcelain tube 2 is surrounded by a sheet metal tube 9 with an annular space 10 between them. The tube 10 completely encompasses the tube 2 at the bottom, and opens up to the interior of the canteen through the small tube 15. When the canteen is filled with water the cap 31 is now removed, and by means of the handle 30 the plunger 28 is rapidly reciprocated in the tube 19. At each upward stroke exterior air passes the soft flexible flange of the plunger, and as the plunger is driven down the flange expands by the resistance of the air in front of it and the air is

driven through the yielding valve 23. This valve at the end of each downstroke of the plunger by force of the action of the spring 25 and the back pressure of the air is immediately reseated. The continued action of the air pump here described will quickly place the contents of the canteen under great pressure. The water is now forced through the bottom of the tube 15 up into the annular chamber of the tube 9, surrounding the filtering tube, and the air pressure upon the water forces the water through the pores of the filtering tube 2. (See page 2, lines 21 through 40 of Hall.)

Hall clearly and unequivocally does not show a siphon space between the filter element and a siphon shield as claimed in claim 1. In Hall liquid moves in the annular space 10 not by a siphon effect but by pressurization using essentially what is a pump 28. There is absolutely no indication whatsoever that the siphon shield significantly reduces the amount of air radially flowing through the filter element with water when parts of the filter element are uncovered by water, or even that any parts of the filter element will be uncovered with water during operation of the Hall canteen because of the pressurization feature thereof. Also if the Hall canteen is inverted so that the element 17 is at the bottom, then the only water that will pass through the filter element 2 is the water that is already within the volume defined by the reference numerals 9 and 14 since nothing further can flow through the tube 15.

With respect to the dependent claims, the tube 9 of Hall is specifically and unequivocally stated to be sheet metal (page 1, line 66), not plastic. Thus there clearly is no anticipation of any claims by Hall.

Reconsideration is also respectfully requested of the rejection of claims 1, 5 through 9, 11 through 13, and 19 through 23 as anticipated by Reid '878, which is commonly owned with the instant application.

Claim 1 has been amended to include the limitations of claim 2, and Reid clearly does not apply thereto. With respect to claim 6, Reid clearly and unequivocally does not show a drinking straw. Not every tube is a drinking straw, and the flexible tube 40 of figure 5 clearly and unequivocally does not function as a drinking straw but rather is a dispensing tube which provides a siphoning action. It is not designed to function like a conventional drinking straw. Also, the shroud of figure 5 of Reid (or actually any figure of Reid) clearly and unequivocally does not cooperate with the filter element and the bottom of a bottle as specifically set forth in claim 6 or the claims which depend therefrom. With respect to claim 19, these same distinctions exist.

Also the Reid design is entirely different than the structures of any of the claims to which it has been applied. The Reid patent depends solely upon gravity and the natural phenomena of a siphon to dispense water, and does not in any way, shape or form relate to utilization of a drinking straw or a collapsible bottle to assist in dispensing or exit filtration. Thus there clearly is no anticipation of any of the claims by Reid.

Reconsideration is also respectfully requested of the anticipation rejection based upon Hatch as applied to claims 1 through 5, 11 through 13 and 14 through 17. In Hatch the figures 1 and 2 embodiment is totally irrelevant to the claimed invention. There is absolutely no indication whatsoever in Hatch that the element 15 provides a siphon space between the filter element and the siphon shield, and this embodiment of

Hatch would definitely not allow the results obtained according to the invention to be achieved because the opening provided by the inlet end piece 17 is at the wrong end of the structure 15 to function like the invention (see figure 1 of the instant application drawings) of claims 1 and 14.

With respect to the figures 3 and 4 embodiment of Hatch, that also is far afield from the invention. That filter construction is specifically and unequivocally mounted exteriorly of the bottle and requires the additional filter media 60, 61 defined by two different walls 43, 62, which is specifically contrary to what is recited in claims 1 and 14. Thus there is no anticipation of any claim by Hatch.

Reconsideration is also respectfully requested of the rejection of claims 2 through 4 and 14 through 17 as obvious over Reid in view of Magnusson. This is not a situation where a non-spill valve is provided to avoid accidental spills. The entire functionality of the Reid structure, relying solely on gravity flow and primarily from an inverted bottle, is completely alien to that of Magnusson, and neither Reid nor Magnusson are concerned with the same proximate problem as the invention. Putting the Magnusson cap on the Reid device would make it incapable of performing its intended function, and would not provide what is recited in the claims at issue.

In determining the propriety of a rejection under 35 USC §103, it is well settled that the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598, 1599 (Fed. Cir. 1988); *Ashland Oil, Inc. v Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 USPQ

657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed.Cir. 1984). The law of the Federal Circuit is that "[a] *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976), emphasis added. See also *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("In determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." (emphasis added)).

Here there clearly is no suggestion within the art to provide the invention since the references do not deal with the same proximate problem as the invention, namely the air expelling problem with squeezable bottles or the like, discussed above. Where the references do not deal with the same proximate problem as each other or the invention there can be no *prima facie* case of obviousness. See *In re Pye*, 148 USPQ 426, 429 (CCPA 1966) wherein the Court held:

"While, as an abstract proposition, it might be possible to select certain statements from Fikentscher and mechanically combine them with Touey to arrive at appellants' claimed combination, we find absolutely no basis for making such a combination. Neither reference is directed to the problem solved by appellants' invention, namely developing a cleaning composition for the skin having improved lubricity characteristics. In our view, only appellants' specification suggests any reason for combining the teachings of the prior art but use of such suggestion is, of course, improper under the mandate of 35 USC 103. *In re Shaffer*, 43 CCPA 758, 229 F.2d 476, 108 USPQ 326." (Emphasis added.)

Further, the references do not teach the advantages achievable according to the present invention, namely substantially complete emptying of capped bottles without significant air ingestion when the filter is exposed. In fact in Magnusson the filter is so remote from the cap that Magnusson would have the problem with the invention solves even more so than the specific art over which the invention is an improvement. Where the art does not suggest the advantages achievable according to the invention there is no *prima facie* case of obviousness. See *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984):

"We are persuaded that the board erred in its conclusion of *prima facie* obviousness. ... The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

Reconsideration is also respectfully requested of the rejection of claims 6 through 9 and 19 through 23 on page 4 of the Action combining Hall or Hatch with Magnusson figure 5. The Magnusson figure 5 embodiment is specifically and unequivocally contrary to Hall and Hatch, and has the problem that is solved according to the invention, as do Hall or Hatch. There is no basis upon which one can combine the mutually exclusive teachings of Hall, Hatch, and Magnusson in the name of obviousness. Rather the rejection of these claims based upon the combination of those references is based solely upon hindsight, selecting what is convenient for a rejection while ignoring teachings specifically contrary. This never can be considered proper. See *In re Kamm*, 172 USPQ 298, 301, 302 (CCPA 1972) wherein the Court held:

"The rejection here runs afoul of a basis mandate inherent in '103 -- that 'a piece-meal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. *In re Rothermel*,

47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). 'It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.' ... However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made." (Emphasis added.)

Further, there is no *prima facie* case of obviousness of Hall or Hatch in view of Magnusson for the same reason as discussed above with respect to the combination of Reid and Magnusson, citing *In re Fine, supra*, *In re Pye, supra*, and *In re Gordon, supra*.

With respect to the rejection of claim 10 on page 4 of the previous Action, there is no doubt that the filter recited in claim 10, *per se*, is well known in the art. However that does not provide a suggestion for using it anywhere one desires. A *prima facie* case of obviousness is still required, and none is provided here.

In conclusion, all of the claims clearly patentably distinguish from the art therefore early passage of the subject application to issue is earnestly solicited.

Should any small matters remain outstanding it is requested that the undersigned attorney be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action and amendment.

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Respectfully submitted,

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